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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,604	04/09/2001	Ian McArthur Anderson	11932/1	2336

26646 7590 04/23/2003

KENYON & KENYON  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER

PARADISO, JOHN ROGER

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 04/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/720,604

Applicant(s)

ANDERSON, IAN MCARTHUR

Examiner

John R. Paradiso

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendments*

1. Applicant's arguments filed 1/31/2003 have been considered but are moot in view of the new ground(s) of rejection.
2. In view of the amendments filed 1/31/2003, the objections to the claims due to improper dependency are hereby withdrawn.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 and 53-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 line 9 recites the phrase "adapted to". It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform.. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 63 USPQ 138.

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In claim 1 line 9, the “annular sealing face” has no antecedent basis.

In claim 4 line 6, the gripping jaw has no antecedent basis.

Claim 53 line 2 recites the phrase “adapted to”. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform.. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 63 USPQ 138.

Claim 54 lines 9 and 12 recite the phrase “adapted to”. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform.. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 63 USPQ 138.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-13, 15-28, 30, 31, and 33-60 are rejected under 35 U.S.C. 102(b) as being anticipated by DUFRENE (WO89/00952).

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DUFRENE discloses a method, apparatus, and container in which a tubular, aseptic sterilization / filling head (1) is provided with a tubular body (20), which engages with the sealing flange (7) of a container, which container may have been previously sterilized. The tubular body is movable to control the flow of flowable material (e.g., product) through a product channel (18). Sterilization fluid (i.e., steam) is passed through sterilization fluid channels (12, 13) to sterilize the chamber formed by the tubular body, as well as a plug (5). After sterilization, the plug is gripped by plug grippers and removed from the fill opening of the container, a gripper ram pulls the plug grippers axially away from the container, simultaneously opening the product channel, product flows into the container through the sterilization / filling head chamber, after which the gripper ram moves downward, replacing the plug into the mouth of the container. The plug circumference is undercut to give the grippers purchase.

(See DUFRENE pages 2-4 and Figure 1.)

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14, 29, 32 rejected under 35 U.S.C. 103(a) as being unpatentable over DUFRENE.

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DUFRENE discloses a method, apparatus, and container, as described above.

DUFRENE does not disclose the specifics of the gripper jaw control or the exact temperature of the steam.

Regarding claim 14, Applicant is given Official Notice that the use of mechanical jaws is notoriously well known in the art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a jaw arrangement as claimed in the invention of DUFRENE in order to minimize the need for additional control circuits.

Regarding claim 29, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use steam at the best temperature for sterilization and thermoplastic weakening in the invention of DUFRENE, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)

*Reference Citations*

9. The following prior art made of record and not relied upon is considered pertinent to

Applicant's disclosure:

- PERIGO ET AL discloses sealing and sterilizing with superheated steam.
- JANOVTCHIK discloses sealing and sterilizing with superheated steam.
- HERZOG discloses a sealing a container using steam to soften and bond thermoweldable material.
- HARDY discloses using steam to heat-seal lids on containers.
- SCHROEDER disclose sterile sealing of containers with threaded caps.
- STEWART ET AL disclose sterile sealing of containers with threaded caps.
- HELMUT discloses aseptic sealing of a container within a sterilization / filling head.
- CACCINI discloses aseptic sealing of a container within a sterilization / filling head.
- CRITCHLEY ET AL discloses a cap gripper arrangement.
- DAMEN discloses a cap gripper arrangement.
- OYAGI discloses a cap gripper arrangement.

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*Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center receptionist.



Examiner John Paradiso	(703) 308-2825
Fax (Direct to Examiner):	(703) 746-3253
Supervisor Rinaldi Rada	(703) 308-2187
Receptionist	(703) 308-1148

April 20, 2003